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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,133	09/24/2003	Iain Cameron Macaulay	MRKS/0094	2573

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EXAMINER

BOCHNA, DAVID

ART UNIT PAPER NUMBER

3679

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/670,133

Applicant(s)

MACAULAY, IAIN CAMERON

Examiner

David E. Bochna

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 14-25 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Claims 26-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected method, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/23/04.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the subject matter of claims 10-13 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Information Disclosure Statement

3. The information disclosure statement filed 9/24/03 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. The "Great Britain Search Report" was not reviewed because each reference cited in the search report must be listed separately on the IDS.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-9 and 14-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Sivley, IV '220.

In regard to claim 1, Sivley discloses an expandable tubular coupling comprising:

a threaded male portion 130; and

a corresponding threaded female portion 131, the threaded portions featuring thread profiles configured such that the coupling may be made up to a predetermined extent, and once made up to said predetermined extent may be made up no further (the threads are wedge threads limiting make up distance).

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In regard to claim 2, wherein each thread portion comprises first and second parts having different thread profiles (see col. 15, lines 8-12).

In regard to claim 3, wherein the male portion has a leading part with a thread profile corresponding to the thread profile of a trailing part of the female portion (see fig. 5a).

In regard to claim 4, wherein the male portion has a trailing part with a thread profile corresponding to a thread profile of a leading part of the female portion (see fig. 5a).

In regard to claim 5, wherein the thread profiles are configured such that the thread portions may be made up until the start of the thread profile on the trailing part of the male portion encounters the start of the different thread profile on the trailing part of the female portion (they are wedge threads).

In regard to claims 6 and 19, wherein the change in thread profiles between the leading part of the female portion and the trailing part of the female portion is abrupt (a combination of threads as disclosed in col. 15, lines 22-27 would lead to an abrupt change).

In regard to claims 7 and 20, wherein the change in thread profiles between the leading part of the female portion and the trailing part of the female portion is gradual (see fig. 5a).

In regard to claims 8 and 21, wherein the change in thread profiles between the leading part of the female portion and the trailing part of the female portion is incremental (see fig. 5a).

In regard to claim 9, wherein the thread profiles are a combination of a square thread profile and a dovetail thread profile (see col. 15, lines 22-27).

In regard to claim 14, wherein the thread profiles are a combination of similar form but differently dimensioned thread profiles (see fig. 5a the wedge threads are similar but vary in width along the length of the threaded sections).

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In regard to claim 15, wherein the thread profiles are square thread profiles (see col. 15, line 23).

In regard to claim 16, wherein the thread profiles are dovetail profiles (see col. 14 lines 59-60).

In regard to claim 17, wherein a smaller thread profile is provided on the leading part of the male portion and is adapted to mate with a similarly dimensioned thread profile provided on the trailing part of the female portion (see fig. 5a).

In regard to claim 18, wherein a larger dimensioned thread profile is provided on the trailing part of the male portion and leading part of the female portions, which larger dimensioned thread profiles are engageable with each other but are not engageable with smaller thread profiles provided on the leading part of the male portion and a trailing part of the female portions respectively.

In regard to claim 22, wherein the thread profiles are parallel (see fig. 5a where the male profile is parallel to the female thread profile).

In regard to claim 23, the thread profiles are tapered (see fig. 5a)

In regard to claim 25, wherein the thread profiles are right hand.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 10-12 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sivley, IV.

In regard to claims 10-12, Sivley discloses using a combination of square and dovetail threads, but does not specifically disclose which threads would be placed on the leading edge. However, it would have been obvious to a person having ordinary skill in the art to place square profile on the leading edge of the male component and the trailing edge of the female component because the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). Because the threads increase in width along the length of the threads from the leading edge to the trailing end of the male and female (see fig. 5a) it is inherent that the front male threads with small widths would fit into the wide threads at the leading edge of the female member, and as the

In regard to claim 24, it would have been obvious to make the right hand threads left hand threads because the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

Allowable Subject Matter

8. Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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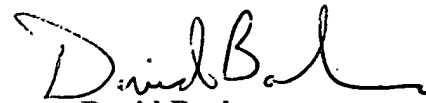
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Metcalfe, Sivley, IV et al. '287 and DeLange et al. all disclose similar couplings common in the art.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Bochna whose telephone number is (703) 306-9040. The examiner can normally be reached on 8-5:30 Monday-Thursday and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703) 308-2686. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168.



David Bochna
Primary Examiner
Art Unit 3679
November 14, 2004